

**REMARKS**

This Amendment responds to the Office Action mailed April 2, 2008 in the above-identified application. Based on the foregoing amendments and the following comments, careful reconsideration and allowance of the application are respectfully requested.

Claims 1-36 are pending in the application. Claims 1-22 and 24-26 have been withdrawn from consideration. By this Amendment, claims 23 and 30 have been amended solely for clarification and not to distinguish over the prior art of record. Accordingly, claims 23 and 27-36 are currently under consideration, with claim 23 being the sole independent claim. No new matter has been added.

The Examiner has objected to the specification since it refers to claims 22 and 23 on page 2. The specification has been amended at pages 2 and 4 to delete the references to specific claims. Accordingly, withdrawal of the objection to the specification is respectfully requested.

The Examiner has objected to the drawings as failing to comply with 37 C.F.R. §1.84(p)(5) because they include reference character 12 not mentioned in the description. The specification has been amended at page 6 to add reference character 12. Accordingly, amendment of the drawings is not required, and withdrawal of the objection to the drawings is respectfully requested.

The Examiner has rejected claims 23 and 27-35 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim subject matter which Applicant regards as the invention. The Examiner asserts that the terms "plate-like" and "disk-like" render the claims indefinite. Claims 23 and 30 have been amended to recite a disk-shaped and a plate-shaped production part, as clearly shown and described in the specification. Accordingly, the amended claims are in compliance with 35 U.S.C. §112, second paragraph, and withdrawal of the rejection is respectfully requested.

The Examiner has rejected claims 23 and 27-36 under 35 U.S.C. §103(a) as unpatentable over Fernandez (U.S. 5,865,358) in view of Gold (U.S. 3,086,365). The rejection is respectfully traversed for the following reasons.

Amended claim 23 is directed to a workpiece cracking device, the workpiece being any one of a disk-shaped and a plate-shaped production part having a pre-specified fracture plane, the workpiece cracking device comprising a base, a first pair of jaws immovably mounted on the base, a second pair of jaws movably mounted on the base, a drive moving, in operation, the movably mounted second pair of jaws periodically to and fro, and a control unit with which the frequency and force of the to and fro movement of the second pair of jaws can be adjusted.

Fernandez does not teach or suggest a workpiece cracking device comprising a “drive moving, in operation, the movably mounted second pair of jaws *periodically to and fro*” as recited in claim 23. On the contrary, the breaker machine disclosed in Fernandez is designed to separate a bundle of sheets, such as paperboard, “in two, arcuate and progressively severing motions which result in clean breaks with a minimum amount of energy” (column 5, lines 24-26). Thus, the disclosure of Fernandez lacks at least two limitations of amended claim 23, i.e., a drive moving the second pair of jaws periodically to and fro, and a control unit adjusting the frequency and force of the to and fro movement of the second pair of jaws.

In clear contrast to the machine configuration of Fernandez, the present invention provides a device that enables processing of a workpiece by “damaging the material in the fracture area not...in an abrupt way” but by allowing “the forces required for this to act on the decisive areas of the production part in the form of alternating stress” so that “the material’s structure is...slowly “worn down” by an alternating load in the decisive area”. (Specification, page 2, paragraph 2). This alternating stress (or load) acting on the decisive area is generated by a periodic to and fro movement of the second pair of jaws, as required by claim 23. By contrast, Fernandez teaches that “the opposite edge of second bundle portion is forced away from the first bundle portion so as to complete a very rapid and clean break between the bundle portions” (column 1, lines 62-65).

The skilled person would have found no motivation in Fernandez to modify the breaker machine disclosed therein by including a drive and a control unit for enabling a periodic to and fro movement of the jaws. On the contrary, Fernandez teaches the skilled person away from such an approach. The breaker machine disclosed in Fernandez is configured for separating bundles of sheets, such as paperboard, into multiple stacks. This process is achieved by an arcuate motion of the jaws (clamping members) which “instantly and cleanly tears connecting portion 33 apart” (column 3, lines 30-31). This “instant” tear is regarded as advantageous since it allows the bundles of sheets to be “quickly and cleanly severed” resulting in “clean breaks with a minimum amount of energy” (column 5, lines 23-26). Thus, the teaching of Fernandez clearly suggests to the skilled person that a non-instant tear, e.g., by slowly “wearing down” the material structure, as is achieved by the device of Applicant’s claim 23, would be both detrimental to the quality of the obtained break and inefficient with respect to the amount of energy required for this process. The skilled person therefore would not have modified the breaker machine of Fernandez according to the device of amended claim 23.

Furthermore, a combination of Fernandez and Gold does not disclose all the features of amended claim 23. In particular, Gold does not teach a drive moving a second pair of jaws periodically to and fro and a control unit adjusting the frequency and force of the to and fro movement of the second pair of jaws. Thus, if the skilled person had combined the teachings of Fernandez and Gold, he would still not have arrived at the workpiece cracking device of amended claim 23.

In addition, it is highly questionable that the person skilled in the art of workpiece cracking devices would have turned to Gold. On the one hand, Fernandez provides no motivation to augment the breaker machine disclosed therein with a reciprocating drive and a corresponding control unit, as discussed above, and thus gives no incentive to the skilled person to seek such components. On the other hand, Gold teaches a hydraulic flow control system and therefore falls within a technical field that is substantially different from that of Fernandez. Thus, it is submitted that the combination of Fernandez is improper and should be withdrawn.

For at least these reasons, amended claim 23 is clearly and patentably distinguished over Fernandez in view of Gold. Claims 27-36 depend from claim 23 and are patentable over Fernandez in view of Gold for at least the same reasons as claim 23.

Based upon the above discussion, claims 23 and 27-36 are in condition for allowance.

### **CONCLUSION**

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

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Respectfully submitted,

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